

REMARKS

The Finality of the Action

This Action is a second Action on the merits, but the Action contains new grounds of rejection. In making the Action final, the Examiner explains that applicants' amendment necessitated the new grounds of rejection. No details of the amendment which might be relevant to the new grounds of rejection were cited.

The amendments to the claims were made entirely divorced from the issues of the prior art. Three general purposes were fulfilled by the amendments. These included: to better conform the claims with conventional US practices, to clarify issues of antecedents, and to adopt more conventional transitional language. A § 112, second paragraph rejection was overcome by replacing the term "and/or" with more conventional language having the same meaning.

None of the amendments to the claims were directed to the issue of scope or were relied upon in any manner to change the scope of the claims for overcoming the cited references. The references were overcome on the basis of the scope of the claims as originally filed.

The current rejections do not refer to the amendment, do not rely on any of the language of the amendment, and differ only on account of the prior art being different. The same rejections could have been made earlier and with the same relevance to the claims. The new grounds of rejection were required because the previous grounds of rejection were overcome by eliminating one of the cited patents as a reference and by challenging the propriety of the suggested combination on the grounds that (a) no motivation was found in either reference for making the suggested combination, (b) neither reference considered the problem of volume resistivity dealt with by the claimed invention, and (c) that the proposed combination would change the entire character of the device so modified.

The changes to the claims contributed to the use of more conventional phraseology, but did not necessitate a new grounds rejection over the prior art. Accordingly, the finality of the Action is believed premature, and the Examiner is respectfully requested to withdraw the finality of the Action.

§103 Rejections

Claims 1 - 3 and 5 - 9 stand rejected as being obvious over US Patent 5,296,658 to Kramer et al. in view of US Patent 5,438,798 to Plamper et al. Kramer et al. are credited with disclosing several of the elements of claim 1 including copper drain wires 30 and 31, which the Examiner regards as the claimed electrically conductive portions, and a U-shaped metal insert 14, which the Examiner regards as the claimed metallic conductor configured as a carrier. However, the Examiner acknowledges that missing from Kramer et al. is a further requirement of claim 1 for one of the electrically conductive portions to be electrically connected to the conductive carrier. The missing electrical connection is said to be found in FIG. 9 of Plamper et al. Plamper et al. are said to disclose a wire connection 362 between a corresponding conductive member 160/360 and a ground screw 314.

At issue with regard to the proposed combination is whether the wire connection 362 from the conductive member 160/360 to the ground screw 314 of Plamper would lead one of skill in the art to modify Kramer et al. to make an electrical connection between Kramer's drain wire 30 and U-shaped metal insert 14. Plamper's purpose for making the connection is to complete a portion of an electrical circuit between a positive wire 302 and a ground wire 304. The Examiner offers two possible motivations. The first motivation parallels Plamper's purpose of completing an electrical connection to close an electrical circuit. The second motivation is to ground the circuit incorporating inherent teaching of a grounding member. The two proposed motivations are discussed separately below:

Regarding the first proposed motivation, Kramer et al.'s safety edge switch already includes two drain wires 30 and 31 for this purpose. In fact, Kramer et al. explain this very function in column 2, lines 53-58 as follows:

Those skill in the art will recognize that continuity of the drain wire circuit may be provided by connecting drain wires 30, 31 through resistor 200 which provides a known impedance at the end of switch 10 opposite the end which is connected to a motor controller 202.

Thus, Kramer et al. already provide all of the connections required for completing an electrical circuit for their safety edge switch. If Kramer et al. were instead to adopt the Examiner's suggestion, Kramer et al.'s electrical circuit would not be completed. Kramer et al.'s U-shaped metal insert 14 is provided to secure a seal 12 to a window frame 17. Merely connecting one conductive portion of Kramer et al.'s switch to the metal insert 14 would not complete any electrical circuit apparent in Kramer et al. Since the window frame 17 is itself not metallic, nor further path for conduction is apparent, and Kramer et al.'s switch would not function as intended.

Regarding the second motivation, the term ground wire is used in Plamper et al. as a return wire of an electrical circuit. Both wires 302 and 304 of Plamper et al. are continuations of a wiring harness 300. The suggestion of a ground wire and screw is not in fact a separate suggestion in accordance with the teaching of Plamper et al. The ground connection of Plamper et al. is the same as the circuit connection of Plamper et al.

Whether Plamper et al. separately suggest grounding or not, the metal insert 14 of Kramer et al. has no connection to ground, and any alternative connection of Kramer et al.'s switch to the metal insert 14 would neither connect Kramer et al.'s switch to ground nor complete the required circuit.

Moreover, claim 1 has been amended to specify that the metallic conductor is configured as a carrier that reinforces the shaped seal. Neither the wire connector 362 nor the ground screw 314 of Plamper et al. qualify as a

carrier that reinforces a shaped seal. No suggestion can be taken from Plamper et al.'s wire or ground screw that a metallic conductor of such a switch circuit should be in the form of a carrier that reinforces a shaped seal. Plamper et al. teach an alternative way of completing an electrical circuit (connecting two wires and anchoring them together with a screw), but this is not the way set forth in claim 1. Thus, Kramer et al. would not learn from Plamper et al. the missing information for connecting the electrically conductive portion of a switch to a metallic conductor configured as a carrier that reinforces the shaped seal.

Dependent claim 4 is rejected over the combination of Kramer et al. and Plamper et al. in further view of US Patent 4,271,634 to Andrzejewski. The Examiner acknowledges that Kramer et al.'s U-shaped insert 14 is not provided with the claimed recess. The Examiner finds such a recess in the channel-shaped sealing strips of Andrzejewski. However, the combination of these three references is still deficient for the reasons noted above. Andrzejewski's metal carrier for a channel-shaped sealing is nowhere suggested as a component of a switch circuit.

In fact, there is no teaching in any of the cited art as to why one would even want to use a carrier that reinforces a seal as a metallic conductor connected to a conductive portion of a switch. In particular, none of the cited references suggests the need for reducing volume resistivity in such a device. Kramer et al. provide the usual electrical connections for completing a switch circuit using copper drain wires. The teaching of Plamper et al. that alternative electrical connections can be made with wires and screws in a switch circuit does not suggest to Kramer et al. that Kramer et al.'s wire connections should be forgone in favor of using a mounting element that happens to be metal for purposes of mounting a seal.

New claim 10 further defines both the shaped seal and the carrier as well as a relationship between the two. The shaped seal is required to comprise a

clamping portion including a recess and a sealing portion. The carrier is required to have a U-shaped cross section arranged for clasping the recess.

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In view of the above amendment and remarks, the application is believed to be in condition for allowance. Accordingly, reconsideration and allowance of all pending claims 1 through 10 are respectfully requested.

Respectfully submitted,



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